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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/025,947	12/26/2001	Hsuan-Yin Lan-Hargest	15128.0003 C1	8464
27890 7590 12/16/2010 STEPTOE & JOHNSON LLP 1330 CONNECTICUT AVENUE, N.W. WASHINGTON, DC 20036				
EXAMINER				
ZUCKER, PAUL A				
ART UNIT		PAPER NUMBER		
1621				
MAIL DATE		DELIVERY MODE		
12/16/2010		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/025,947

**Applicant(s)**

LAN-HARGEST ET AL.

**Examiner**

Paul A. Zucker

**Art Unit**

1621

**Period for Reply** -- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 09 August 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-5, 7, 8, 12, 13, 16, 17, 22, 25, 26, 80-94, 96, 97 and 99-103 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5, 7, 8, 12, 13, 16, 17, 22, 25, 26, 80-94, 96, 97 and 99-103 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of Filing/Response Cited (PTO-532)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 9 July 2010 has been entered.

### ***Current Status***

2. This action is responsive to Applicants' submission of 9 August 2010.
3. Receipt and entry of Applicants' amendment is acknowledged.
4. Applicant's cancellation of claims 6, 9-11, 14-15, 18-21, 23, 24, 27-79, 95 and 98 is acknowledged.
5. Claims 1-5, 7, 8, 12, 13, 16, 17, 22, 25, 26, 80-94, 96, 97 and 99-103 are pending.
6. The rejections under 35 USC § 112, first paragraph, set forth in paragraphs 4-9 of the previous Office Action mailed 9 April 2010 are withdrawn in response to Applicants' amendment.
7. The rejection under 35 USC § 112, second paragraph, set forth in paragraph 12 of the previous Office Action mailed 9 April 2010 is withdrawn in response to Applicants' amendment.

Art Unit: 1621

8. The rejections under 35 USC § 102 set forth in paragraphs 13 and 14 of the previous Office Action mailed 9 April 2010 are withdrawn in response to Applicants' amendment.

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***New Rejections***

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***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

9. Claims 85-94, 96, 97 and 99-103 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. There is no support for the limitations which define a subgenus of L having a range of carbons other than C<sub>3-12</sub> or C<sub>4-8</sub>. Applicants' amendment introducing the new ranges where L is C<sub>5-8</sub> (in claims 85, 89), C<sub>4-6</sub> (in claims 91 and 103), C<sub>5-6</sub> (in claim 100), and C<sub>4-7</sub> (in claim 102) do not find support in the specification as filed.

The claim language constitutes new matter because the written description of the instant specification does not "reasonably lead" those skilled in the art to this particular subgenus of compounds. (MPEP 2163.05).

10. Claims 1-5, 7, 8, 12, 13, 16, 17, 22, 25, 26, 80-94, 96, 97 and 99-103 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. There is no support for the limitation which defines a subgenus of L "containing at least one double bond adjacent to Y<sup>1</sup> or Y<sup>2n</sup>". Independent claims 1, 22, 80, 91, 102 and 103 contain this limitation which does not find support in the specification as filed.

The claim language constitutes new matter because the written description of the instant specification does not "reasonably lead" those skilled in the art to this particular subgenus of compounds. (MPEP 2163.05).

#### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

11. Claims 1-5, 7, 8, 12, 13, 16, 17, 22, 25, 26, 80-84, 87, 88, 102 and 103 are rejected under 35 U.S.C. 102(b) as being anticipated by Chiusoli et al (US 4,355,168 10-

Art Unit: 1621

1982). Chiusoli discloses (Column 4, lines 34-36), the compound 6-phenyl-3 (E), 5(E)- hexadienoic acid having the structure:  $\text{Ph-CH=CHCH=CHCH}_2\text{CO}_2\text{H}$  and an aqueous solution of its sodium salt corresponding to a pharmaceutical composition.  $\text{Ph-CH=CHCH=CHCH}_2\text{CO}_2\text{H}$  corresponds to an instantly claimed compound in which A is phenyl (unsubstituted), L is a  $\text{C}_4$  all-trans diolefin,  $\text{Y}^1 = \text{a bond}$ ,  $\text{Y}^2 = \text{CH}_2$ ,  $\text{X}_1, \text{X}_2 = \text{O}$ . Chiusoli therefore anticipates claims 1-5, 7, 8, 12, 13, 16, 17, 22, 25, 26, 80-84, 87, 88, 102 and 103.

### ***Conclusion***

12. Claims 1-5, 7, 8, 12, 13, 16, 17, 22, 25, 26, 80-94, 96, 97 and 99-103 are pending.

Claims 1-5, 7, 8, 12, 13, 16, 17, 22, 25, 26, 80-84, 87-94, 96, 97 and 99-103 are rejected.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul A. Zucker whose telephone number is 571-272-0650. The examiner can normally be reached on Monday-Friday 5:30-3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel Sullivan can be reached on 571-272-0779. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1621

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Paul A. Zucker/  
Primary Examiner, Art Unit 1621